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EXAMINER

GONZALEZ, MADELINE

ART UNIT

PAPER NUMBER

1797

MAIL DATE

DELIVERY MODE

12/30/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/589,964

**Applicant(s)**

KLEIN ET AL.

**Examiner**

MADELINE GONZALEZ

**Art Unit**

1797

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 October 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 11, 12 and 14-24 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 11, 12 and 14-24 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/S5108)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### DETAILED ACTION

In response to applicant's amendment dated October 22, 2008

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 11, 14-21, 23 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over a combination of Nichtnennung (DE 3100499A1) and Selz (U.S. 4,529,515).

With respect to **claim 11**, Nichtnennung discloses a filter device, as shown in Fig. 1, having:

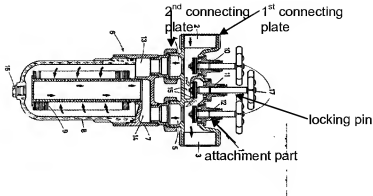
- a filter housing 6 having first and second fluid connections and an exterior surface;
- a filter element 9 held in said filter housing 6;
- a fluid container having an exterior surface, said fluid container being the element connected to the filter device (not shown), and
- a connector 1 coupling said fluid connections to said fluid container, said connector 1 having at least one longitudinally displaceable blocking part 10, 11, 12, blocking said fluid connections in a blocking position thereof and opening

said fluid connections in an open position thereof, said blocking part 10, 11, 12, being located between and accessible from said exterior surfaces of said filter housing 6 and said fluid container when said filter housing 6 and said fluid container are coupled by said connector 1;

- wherein said blocking part 10, 11, 12, includes a plate-shaped sliding valve part guided for movement between first and second connecting plates of said connector 1, as shown in the figure below.

Nichtnennung **lacks** seals facing the filter housing and facing the fluid container.

Selz teaches a valve 1, as shown in Fig. 1, having a sphere 10 (rotationally displaceable blocking part), blocking fluid connections 2 and 3. Sealing elements 22 bear against the adjacent portions of the external surface of sphere 10 to prevent the flow of fluid from the passage 33 into the passage 21 when the sphere 10 is rotated (see col. 7, lines 18-28). It would have been obvious to provide the blocking parts disclosed by Nichtnennung with sealing elements as taught by Selz in order to prevent flow of fluid from one passage to another when the blocking parts are moved (see col. 7, lines 18-28).



**Claim 12** adds the further limitation of a hydraulic tank. Selz discloses that the filter assembly can be used to filter hydraulic fluid. It would have been obvious to provide a hydraulic tank in order to store the hydraulic fluid.

With respect to **claim 14**, Nichtnennung discloses wherein said fluid connections include a fluid inlet and a fluid outlet in said filter housing 6; said connecting plates include fluid passages corresponding to and forming part of said fluid connections; and said blocking part 10-12 has wall parts that cover said fluid connections in the blocking position and clear said fluid connections in the open position, as shown in Fig. 1.

With respect to **claim 15**, Nichtnennung discloses wherein said fluid inlet and said fluid outlet are located one of top of another in a direction of a longitudinal axis of said filter housing 6, as shown in the figure above; said fluid passages are located one on top of another in said direction of said longitudinal axis; and said blocking part 10-12

has clearance openings 15 between said wall parts, said clearance openings 15 being aligned and congruent with said fluid passages in the open position to convey fluid therethrough, as shown in Fig. 1.

With respect to **claim 16**, Nichtnennung discloses wherein said first and second fluid connection has first and second valves 10-12, respectively, as shown in Fig. 1.

With respect to **claim 17**, Nichtnennung discloses wherein said first fluid connection includes a fluid outlet 3, 14, of said filter housing 6, with said first valve 12 having a valve disk located on an outside of and over said fluid outlet 3, 14; and said fluid connection includes a fluid inlet 2, 13, of said filter housing 6, with said second valve 10 having a valve disk integrated within said filter inlet 2, as shown in Fig. 1.

With respect to **claim 18**, Nichtnennung discloses wherein said filter connections of said filter housing 6 are encompassed on an outer peripheral side thereof by an attachment part; and said connector 1 has flange parts on a connecting plate thereof facing said attachment part, said connecting plate having fluid passages therein encompassed by said flange parts, as shown in the figure above.

With respect to **claim 19**, Nichtnennung discloses wherein said attachment part includes a locking part received in an opening in one of said flange parts and in a recess in said blocking part 10-12 in the open position, as shown in Fig. 1.

With respect to **claim 20**, Nichtnennung discloses wherein said locking device includes a locking pin, as shown in the figure above.

With respect to **claim 21**, Nichtnennung discloses wherein each of said filter housing 6 and said blocking part 10-12 include a handle for manual operation thereof, as shown in Fig. 1.

With respect to **claim 23**, Nichtnennung discloses wherein said blocking plate 10-12 moves translationally between the blocking and open positions, as shown in the figure above.

With respect to **claim 24**, Nichtnennung discloses wherein said fluid connections 2 and 3 extend perpendicular to a longitudinal axis of said filter housing.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtnennung (DE 3100499A1) and Selz (U.S. 4,529,515) as applied to claim 11 above, and further in view of Muzik et al. (U.S. 6,579,455) [hereinafter Muzik].

**Claim 22** adds the further limitation of wherein said filter housing comprises cast aluminum; and said blocking part comprises one of steel and plastic.

Nichtnennung and Selz **lack** the specific claimed materials.

Muzik discloses a filter 10, as shown in Fig. 1, having a housing composed of elements 12, 14, 16, made of any suitable material, such as aluminum (see col. 5, lines 54-67 and col. 6, lines 1-5). Muzik teaches that aluminum is a preferred material for its low weight and strength (see col. 8, lines 66-67 and col. 9, lines 1-2). Muzik also discloses a valve 44, as shown in Fig. 9, which can be made of steel or plastic (see col. 9, lines 2-9). It would have been obvious to a person having ordinary skill in the art at the time the invention was made to make the housing and blocking part disclosed by Nichtnennung as modified by Selz of aluminum and steel or plastic, respectively, as taught by Muzik, since Muzik teaches that those are suitable materials known in the art (see col. 9, lines 1-11).

### ***Response to Arguments***

Applicant's arguments filed on October 22, 2008 have been fully considered but they are not persuasive.

In response to applicant's argument that Nichtnennung lacks the blocking part being located between the exterior surfaces of the filter housing and the fluid housing: Nichtnennung discloses blocking parts 10-12 located between the exterior surfaces of filter housing 6 and a fluid container (not shown) connected to the inlet 2.

In response to applicant's argument that Nichtnennung lacks the two connecting plates being sealed to a valve part between the connector plates: Selz teaches a seal, as stated above, and it would have been obvious to provide the blocking parts disclosed

by Nichtnennung with a seal as taught by Selz in order to prevent flow of fluid from one passage to another when the blocking parts are moved.

In response to applicant's argument regarding claim 12, Selz discloses that the filter assembly can be used to filter hydraulic fluid. It would have been obvious to provide a hydraulic tank in order to store the hydraulic fluid.

In response to applicant's argument regarding claim 14: This argument is not persuasive. The parts 10-12 clear the fluid connections in the open position, as shown in Fig. 1 of Nichtnennung.

In response to applicant's argument regarding claim 15, that the reference fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., the inlet and outlet and the fluid passages being located one of top of the other in the direction of the longitudinal axis) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument regarding claims 16 and 17: The limitations of these claims are met by the Nichtnennung reference. Applicant should clarify that the valves are independent elements from the claimed blocking part.

In response to applicant's argument regarding claims 18-20: These arguments have been considered and are not persuasive.

In response to applicant's argument regarding claim 21: Nichtnennung teaches handles 17. It is noted that the features upon which applicant relies (i.e., a handle on

the filter housing) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993). All the claim requires is one handle. Applicant is not claiming two handles, one for the housing and one for the blocking part.

In response to applicant's argument with respect to claim 23: The parts 10-12 rotate and have a translation movement in order to block the fluid connections, as shown in Fig. 1 of Nichttrennung.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MADELINE GONZALEZ whose telephone number is (571)272-5502. The examiner can normally be reached on M, T, Th, F- 8:30am-5:00pm, alternate Fridays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on 571-272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Madeline Gonzalez  
Patent Examiner  
December 24, 2008

/Krishnan S Menon/  
Primary Examiner, Art Unit 1797